

Remarks/Arguments

Please note that the attorney of record and correspondence address in this application has changed. A power of attorney confirming this change has been filed in this application and is of record.

Claims 30, 77, 78, 80, 83, 84, 87, 88, 105, 106, 114-116, 128 and 132-134 are currently pending in this application.

The Abstract has now been limited to one paragraph in accordance with USPTO guidelines. No new matter has been introduced as a result of this amendment.

Claims 26, 74, 84, 87-88, 110, 112-117, 122-126, 128-129 and 131-134 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. This ground of rejection is respectfully traversed.

Claims 25, 26, 74, 79 and 131 have now been canceled without prejudice. Claims 84, 87, 88, 132, 133 and 134 have been amended to remove any perceived ambiguities in the language used to describe the mutations and substitutions. In view of these amendments, applicants submit that the claims under examination are no longer vague or ambiguous.

Claims 25-26, 74, 76-80, 83, 105-106, 110, 112-117, 122-129 and 131-132 have been rejected under 35 U.S.C. 112, first paragraph, for being enabled only for certain species and subgenus of the claimed antibodies. This ground of rejection is traversed.

The rejection of claims 25, 26, 74, 76, 79, 110, 112-113, 117, 122-127, 129 and 131 is moot in view of the cancellation of these claims without prejudice.

Claims 30 and 83 have been amended in order to obviate this rejection. It is submitted that the amendment serves to clarify these claims, and that as amended, the claims are in compliance with all requirements of 35 U.S.C. 112.

Applicants note that the rejection of the pharmaceutical composition claims on the basis of a lack of enablement and written description support has been withdrawn by the Examiner. In addition, applicants note that the Examiner agrees that the specification is enabling for a

recombinant anti-integrin antibody, or an antigen binding fragment thereof, which specifically binds to the open conformation of an α L integrin I-domain relative to the closed conformer of an α L integrin I-domain, and inhibits interaction of LFA-1 integrin and a cognate LFA-1 ligand.

Applicants have deleted the expression “specifically binds” from claim 30 in order to obviate the rejection of this claim based on the use of this particular wording.

Claims 26, 83, 105, 110 and 112-113 have been rejected under 35 U.S.C. 102(b) as being anticipated by Huang et al., Lu et al. and the present specification. This ground of rejection is respectfully traversed.

Initially, it is noted that an anticipation rejection is only proper where all the elements of the claimed invention are found in a single reference. In other words, it is not proper to formulate an anticipation rejection on the basis of more than one reference. Moreover, it is never proper to rely on applicants’ disclosure to reject applicants own claims. This reasoning specifically applies to the Examiner’s inference of equivalency between the E284C/E301C mutant and the K287C/K294C mutant which is found only in applicants own disclosure.

Furthermore, there is no support for the proposition that the antibodies of Lu et al. “would inherently inhibit the interaction of LFA-1 integrin and ICAM-1, ICAM-2 or ICAM-3”. Applicants note that the present claims are not written in product-by-process format where the issue of shifting the burden of proof to applicant would be more appropriately raised. It is applicants position that the burden of establishing such inherency should reside with the Examiner.

Claims 128-129 stand rejected under 35 U.S.C. 103(a) as obvious over the combination of Huang et al., Lu et al. and the present specification. This ground of rejection is traversed.

Claim 129 has now been canceled without prejudice, and claim 128 is solely dependent on claim 84. In view of the amendment of claim 128, it is respectfully submitted that this claim is neither taught nor suggested by the combination of references relied upon in the Official Action for the reasons discussed above.

Claims 114-117 and 122-126 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Huang et al., Lu et al. and the present specification, in view of U.S. Patent No. 6,572,856. Claims 114-117 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Huang et al., Lu et al. and the present specification, in view of

U.S. Patent No. 5,843,712, and further in view of U.S. patent No. 6,572,856. These grounds of rejection are traversed.

Claims 117 and 122-126 have been canceled without prejudice. Claim 114 has been amended to depend solely on claim 84. Claims 115 and 116 are dependent on claim 114. In view of the amendment to claim 84, applicants submit that claims 114-117 are patentable over the cited references for reasons discussed above.

Claims 25, 30, 74, 76-80, 110, 112-113 and 131-132 have been rejected under 35 U.S.C. 103(a) as obvious over the combination of Huang et al., Lu et al. and the present specification, in view of U.S. Patent No. 5,843,712. This ground of rejection is also traversed.

Claims 25 and 75 have been canceled without prejudice, and claims 76 and 77 now depend solely on claim 84. The Examiner has acknowledged that claim 84 is neither taught nor suggested by the cited combination of references. Accordingly, the claims remaining after the amendment are also deemed patentable over the cited references.

Claims 127-130 stand rejected under 35 U.S.C. 103(a) as obvious over the combination of Huang et al., Lu et al. and the present specification, in view of U.S. Patent No. 5,843,712, and further in view of U.S. patent No. 6,413,963. This ground of rejection is traversed.

Claims 127, 129 and 130 have now been canceled without prejudice. Claim 128 is solely dependent on claim 84. In view of the amendments to claims 84 and 128, it is respectfully submitted that claim 128 is neither taught nor suggested by the combination of references relied upon.

The Examiner has indicated that claims 84, 87-88 and 133-134 would be allowable if rewritten or amended to overcome the 35 U.S.C. 112, second paragraph, rejection. Applicants thank the Examiner for this indication of allowability, and note that these claims have been rewritten to overcome the stated rejection. In addition, applicants also note that several of the dependent claims now depend solely on claim 84, and should therefore also be considered allowable without the need for additional review or consideration.

In view of the aforementioned facts and reasons, the pending claims of this application are now believed to overcome any remaining rejections, and to satisfy all requirements for patentability. Accordingly, withdrawal and reconsideration of the rejections, and allowance of the claims in this

application, are solicited. The Examiner is invited to contact the undersigned if this would serve to advance the prosecution of this application.

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